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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,671	09/07/2000	Timothy Richardson	1960.182	2152

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EXAMINER

FINEMAN, LEE A

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/673,671

Applicant(s)

RICHARDSON, TIMOTHY

Examiner

Lee Fineman

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) 3-8, 11-15, 21-24, 32-37, 43, 44 and 68-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 9, 16-20, 38-42 and 45-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 September 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: See Continuation Sheet.

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DETAILED ACTION

This Office Action is in response to an amendment filed 13 June 2003 in paper number 10 in which claims 25-31 were cancelled and claims 45-73 were added. Claims 1-24 and 32-73 are pending.

Election/Restrictions

1. Applicant's election with traverse of Group IV in Paper No. 10 is acknowledged. The traversal is on the ground(s) that a search of the art for one group of claims will necessarily include a search of the art for the other groups of claims and that the burden on the examiner to examine all of the claims in a single application is less than the burden on the applicant to prosecute multiple applications. This is not found persuasive because, as evidenced by the different classes and subclasses for each group, the search would not be the same for each group.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 3-8, 11-15, 21-24, 32-37 and 43-44 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Further, regarding newly added claims 68-73, applicant states that these claims are directed to the same invention as group IV. However, the electric circuit component included in these claims is clearly drawn to the slide systems of groups V-VII, which are non-elected. Therefore, claims 68-73 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Priority

3. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "436" has been used to designate both a stage and an O-ring in fig. 13.

5. The drawings are objected to because reference sign "282" in fig. 11 should be --382--.

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the preselected thickness of each of said slide base, said cover slip and said adhesive being the same as stated in claim 17 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

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7. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

8. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. While the claims are considered part of the original disclosure, a written description of the claimed details must be described in the specification. Accordingly, the specification should be amended to include the claimed subject matter of claim 17. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-2, 9, 16, 20 and 40-42 are rejected under 35 U.S.C. 102(b) as being anticipated by McCormick, U.S. Patent No. 3,879,106.

Regarding claims 1-2 and 40-42, McCormick discloses a slide system (fig. 3) for microscopy comprising a slide base (11); a cover slip (13); and an adhesive layer (15a) on a surface of at least one of said slide base and said cover slip, said adhesive layer surrounding a portion of said surface such that when said slide base and cover slip are engaged with said

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adhesive layer to form an assembled slide, said adhesive layer and said cover slip enclose a sealed sample area (fig. 3, column 3, lines 10-20) and wherein the adhesive layer is located on the slide base (fig. 3). The method of utilizing the structure of the claim is inherent therein.

Regarding claims 9, McCormick further discloses at least one test material (39) applied to at least one of said slide base and cover slip such that said test material is within said sealed sample area (fig. 3).

Regarding claim 16, McCormick further discloses wherein each of said slide base, said cover slip and said adhesive have a preselected thickness such that, when said assembled slide is formed it has a preselected overall thickness (fig. 3).

Regarding claim 20, McCormick further discloses wherein the adhesive is releasable (column 3, lines 57-62).

11. Claims 1-2, 16, 40-42, 45-46, 58 and 66-67 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Den Bosch, U.S. Patent No. 3,482,898.

Regarding claims 1-2, 40-42 and 45, Van Den Bosch discloses a slide system (figs. 1 and 2) for microscopy comprising a slide base (11 with 12); a cover slip (13); an adhesive layer (14) on a surface of at least one of said slide base and said cover slip, said adhesive layer surrounding a portion of said surface such that when said slide base and cover slip are engaged with said adhesive layer to form an assembled slide, said adhesive layer and said cover slip enclose a sealed sample area (fig. 1, column 3, lines 7-11), and wherein the adhesive layer is located on the slide base (fig. 1); and wherein at least one of said slide base and said cover slip includes at least two electrical conductors (15 and 16) extending between said sealed sample area and a surface

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on at least one of said slide base and said cover slip outside said sealed sample area (figs. 1 and 2). The method of utilizing the structure of the claim is inherent therein.

Regarding claim 16, Van Den Bosch further discloses wherein each of said slide base, said cover slip and said adhesive have a preselected thickness such that, when said assembled slide is formed it has a preselected overall thickness (fig. 1).

Regarding claim 46, Van Den Bosch further discloses wherein one of said at least two conductors is on said slide base and the other of said at least two conductors is on said cover slip (fig. 2, both conductors are in contact with both the slide base and cover slip).

Regarding claims 58, 66 and 67, Van Den Bosch further discloses a sample area R defined by a surrounding barrier (12 and 14), which is an adhesive layer, and at least one electrical conductor (15 or 16), integrated with the slide base (figs. 1 and 2), which traverses through the sample area and has at least two electrical contacts (17, 18) located outside the sample area.

12. Claims 58-59, 61 and 63-65 are rejected under 35 U.S.C. 102(b) as being anticipated by Remy et al., U.S. Patent No. 4,231,660.

Remy et al. disclose a slide system/apparatus (fig. 2) for microscopy comprising a slide base (1) having a sample area defined by a surrounding barrier (fig. 2, column 4, lines 52-55); at least one electrical conductor (2), integrated with the slide base, which traverses through or under the sample area and has at least two electrical contacts (10) located outside the sample area; wherein the electrical conductor is disposed underneath the barrier (fig. 2); an insulating coating,

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which is a dielectric coating and biologically and chemically inert, over the conductor within the sample area preventing any electrical contact with any sample (column 5, lines 17-28).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 10, 17, 18, 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick.

McCormick discloses the claimed invention except for including at least two test material with at least one of said test materials being applied to said slide base and at least another of said at least two test materials being applied to said cover slip such that, when said sealed sample area is formed, said test materials on said cover slip are proximal said test materials on said slide base; wherein said test material comprises a biohazardous stain; wherein said preselected thickness of each of said slide base, said cover slip and said adhesive are the same; and a recess in said surface, said adhesive being placed in said recess. Official notice is taken that the use test materials or reagents, including biohazardous stains, are well known in the art for biological analyses. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use two test materials including biohazardous stains in the system of McCormick for specific biological sample analysis. Further, the choice of equal thickness and/or a recess for the adhesive based on, for example, providing stable side by side storage of materials before

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using and the lack of any disclosed criticality to the dimensions indicates such would have been obvious to one of ordinary skill in the art at the time the invention was made.

15. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick in view of Oberhardt, U.S. Patent No. 4,849,340.

McCormick discloses the claimed invention except for a spacer having first and second sides and a preselected thickness and wherein said spacer surrounds said portion of said surface and said first side engages said adhesive on said surface and said second side includes an adhesive to engage the other of said slide base and cover slip, said sealed sample area being formed by said slide base, space, each of said adhesives and said cover slip. Oberhardt teaches in fig. 6 a slide system with a slide base (30), a spacer (20) and two adhesive layers (62), and a cover slip (10) forming a sample area. It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a spacer to the system of McCormick to provide flexibility in adjusting the size of the sample area.

16. Claims 1-2, 16, 40-42, 45, 47, 49-51, 60 and 66-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Remy et al. in view of McCormick or Van Den Bosch.

Remy et al. disclose the claimed invention except for a cover slip; and an adhesive layer on a surface of at least one of said slide base and said cover slip, said adhesive layer surrounding a portion of said surface such that when said slide base and cover slip are engaged with said adhesive layer to form an assembled slide, said adhesive layer, located on the slide base, and said cover slip enclose a sealed sample area. Both McCormick and Van Den Bosch teach slides

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systems with a cover slip and an adhesive layer (as detailed above in the 102 rejections). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a cover slip and adhesive layer as suggested by McCormick or Van Den Bosch to the system of Remy et al. to provide a sealed sample area for better isolation of the sample.

17. Claim 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over Remy et al. in view of Oberhardt.

Remy et al. discloses the claimed invention except for at least one of said conductors being sufficiently resistive to heat said sample area. Oberhardt teaches a slide system (fig. 35) with conductor (238) sufficiently resistive to heat the sample (column 3, lines 48-55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify one of the conductors of Remy et al. as suggested by Oberhardt to provide resistive heating to be able to heat the sample.

18. Claims 48, 52-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Remy et al. in view of McCormick or Van Den Bosch, as applied to claim 45 above, and further in view of Oberhardt.

Regarding claims 52-53 and 55-57, Remy et al. in view of McCormick or Van Den Bosch, as applied to claim 45 above, discloses the claimed invention except for an electrical conductor in said sealed sample area having at least two portions extending outside said sealed sample area. Oberhardt, in fig. 35, teaches a slide system with a slide base (30), a cover slip (10), adhesive (within 60), an electrical conductor (234) in said sample area having at least two

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portions extending outside said sample area (fig. 35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify one of the conductors of Remy et al. in view of McCormick or Van Den Bosch to have two portions extending outside the sample area as suggested by Oberhardt to be able to utilize multiple instrumentation.

Regarding claims 48 and 54, Remy et al. in view of McCormick or Van Den Bosch, as applied to claim 45 above, discloses the claimed invention except for a conductor being sufficiently resistive to heat said sample area. Oberhardt further teaches a conductor being sufficiently resistive (238) to heat said sample area. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify one of the conductors of Remy et al. in view of McCormick or Van Den Bosch as suggested by Oberhardt to provide resistive heating to be able to heat the sample.

Conclusion

19. Applicant stated that a Notification of Acceptance into National Stage had not been received. This notification (form PCT/DO/EO/903) was mailed 25 October 2002 as Paper No. 5. A copy has been attached to this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (703) 305-5414. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (703) 305-0024. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4900.



LAF
August 22, 2003


MARK A. ROBINSON
PRIMARY EXAMINER

Continuation of Attachment(s) 6). Other: Copy PCT/DO/EO/903 (371 Accept. Notice).



UNITED STATES PATENT AND TRADEMARK OFFICE

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U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/673,671	Timothy Richardson	1960.182

INTERNATIONAL APPLICATION NO.

PCT/CA98/00249

I.A. FILING DATE

PRIORITY DATE

03/20/1998

03/21/1997

05514

FITZPATRICK CELLA HARPER & SCINTO
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 NEW YORK, NY 10112

CONFIRMATION NO. 2152

371 ACCEPTANCE LETTER



OC00000009010782

Date Mailed: 10/25/2002

NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C 371 AND 37 CFR 1.494 OR 1.495

The applicant is hereby advised that the United States Patent and Trademark Office in its capacity as an Elected Office (37 CFR 1.495), has determined that the above identified international application has met the requirements of 35 U.S.C. 371, and is ACCEPTED for national patentability examination in the United States Patent and Trademark Office.

The United States Application Number assigned to the application is shown above and the relevant dates are:

09/07/2000

DATE OF RECEIPT OF 35 U.S.C. 371(c)(1), (c)(2) and
 (c)(4) REQUIREMENTS

09/07/2000

DATE OF RECEIPT OF ALL 35 U.S.C.
 REQUIREMENTS

A Filing Receipt (PTO-103X) will be issued for the present application in due course. **THE DATE APPEARING ON THE FILING RECEIPT AS THE " FILING DATE" IS THE DATE ON WHICH THE LAST OF THE 35 U.S.C. 371 REQUIREMENTS HAS BEEN RECEIVED IN THE OFFICE. THIS DATE IS SHOWN ABOVE.** *The filing date of the above identified application is the international filing date of the international application (Article 11(3) and 35 U.S.C. 363).* Once the Filing Receipt has been received, send all correspondence to the Group Art Unit designated thereon.

The following items have been received:

- U.S. Basic National Fee
- Indication of Small Entity Status
- Copy of IPE Report
- Copy of references cited in ISR
- Copy of the International Application
- Copy of the International Search Report
- Oath or Declaration
- Request for Immediate Examination
- Small Entity Statement

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

KAREN R MCLEAN

Telephone: (703) 308-9117

PART 3 - OFFICE COPY

FORM PCT/DO/EO/903 (371 Acceptance Notice)